

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jang, et al.	§	Confirmation No.: 9436
	§	
Serial No.: 10/774,672	§	Group Art Unit: 2617
	§	
Filed: February 9, 2004	§	Examiner: Peaches, Randy
	§	
For: Method and System for Reporting the	§	Attorney Docket No.: 22171.404
Status of a Non-Emergency-Services	§	
Position-Determination Capability	§	

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ARGUMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Final Office Action, claims 8-13, 29, and 31-35 were rejected under 35 U.S.C. §103 as being unpatentable over Havinis, et al. (US Pat. No. 6,311,069, hereinafter referred to as “Havinis”) in view of Zellner, et al. (US Pat. No. 6,675,017, hereinafter referred to as “Zellner”). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to the independent claims 8 and 29, and the claims that depend therefrom.

To establish a *prima facie* case of obviousness, [1] there must be some suggestion or motivation to modify the reference or combine the reference teachings; [2] there must be some reasonable expectation of success; and [3] the prior art must teach or suggest all the claim limitations. MPEP § 706.02(j). All three conditions are required for each claim to be considered *prima facie* obvious. It is submitted that in the present case the Examiner has not factually supported

a *prima facie* case of obviousness, because the combination of Havinis and Zellner (both individually and collectively referred to as “the Combination”) do not teach or suggest all the claim limitations of any of either independent claim 8 or 29.

More particularly, Applicant’s independent claim 8 expressly recites “generating and transmitting a capability request response to each requesting non-emergency-service-provider that includes a **status indicator of a non-emergency-services position-determination (NESP) capability of the station.**” Similarly, Applicant’s independent claim 29 expressly recites “receiving a **status indicator** from the mobile station, at least indirectly, wherein the **status indicator indicates that the mobile station is configured to refrain from providing position information for non-emergency-services.**” Applicant respectfully submits that the cited Combination of references, when taken alone or in combination, fails to teach, show, or suggest these limitations, and as such, Applicant respectfully submits that a *prima facie* obviousness rejection has not been properly established.

Zellner teaches a profile that permits elimination of redundant failed communication *internal* to the system, since the mobile station can instruct the base station to not provide location information, and the base station can act upon future requests with that instruction. However, Zellner does not teach, show, or suggest Applicant’s recited **status indicator** of non-emergency-services position-determination capability, or that the status indicator indicates that the mobile station is configured to refrain from providing position information for non-emergency-services, as recited in each of the rejected claims. There is no teaching in *Zellner* of informing the requestor of

future intent to not respond so that the requestor might choose to cease sending requests and thereby eliminate redundant failed communication *external* to the system. *See* Zellner, column 2, line 65, to column 3, line 13. As such, Applicant submits that Zellner clearly fails to teach, show, or suggest each and every limitation recited in Applicant's claims.

Further, Havinis teaches that the requestor receives a default response (17) from the system after a timer (19) expires prior to receiving a response from the mobile station (20). This process does not include any teaching or suggestion of a status indicator, as expressly recited in each of claims 8 and 29. In Havinis, there is nothing that operates to inform the requestor of the system's current state that will result in future non-responses. Havinis' "default response (17)" provides the requestor with **NO** information on the system's future intent to not respond, so it **CANNOT** equate to the status indicator of the current claims. The requestor will most-likely continue to send requests, not knowing the system's status will not permit a response.

In the Office Action, dated 10/10/2006, the Examiner maintains that Havinis discloses a status indicator in column 6, lines 4-22 and lines 42-50, but there is no element that equates to the status indicator in the cited section. The cited section describes how the mobile user may accept or reject the request message. At lines 13-16, Havinis discloses that the response may be pre-programmed, but this does not teach that the requestor is informed of the pre-programmed response. Nowhere in the section does Havinis describe how the mobile user may inform the requestor that future requests will also be denied, as the status indicator of the current disclosure does.

Therefore, Havinis does not teach or suggest any sort of status indicator that informs a requestor of future system status. In view of Zellner's failure to teach Applicant's expressly recited limitation of the status indicator, Applicant submits that Havinis fails to further the teaching of Zellner to the level necessary to properly support a *prima facie* obviousness rejection of the claims. As such, reconsideration and withdrawal of the rejection of claims 8 and 29, along with each claim depending therefrom, is appropriate.

In conclusion, Applicant submits that neither of the cited prior art references teaches, shows, or suggests the status indicator expressly recited in each of Applicant's claims. The foregoing shows that independent claims 8 and 29 are allowable over the cited prior art, and further, that dependent claims 9-13 and 31-35 are also allowable as a result of being dependent upon an allowable independent claim.

Respectfully submitted,



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